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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,963	01/09/2002	James A. Shayman	30275/38151	2781

7590 10/24/2003

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EXAMINER

RAYMOND, RICHARD L

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 10/24/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

10/030,963

Applicant(s)

SHAYMAN ET AL.

Examiner

Richard L. Raymond

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

1. The drawings filed on June 10, 2003 have been accepted as formal drawings by the examiner.

Obviousness-type Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-7, drawn to products, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,030,995, claims 1-7 of U.S. Patent No. 6,255,336 and claims 1-6 of U.S. Patent No. 6,569,889. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds of the patents are the optical isomers or are generic to the present compounds. No patentable significance is seen therein. The present claims appear to be the elected subject matter of the '336 patent.

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4. Claims 8-17, drawn to methods of use, are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over (1) claims 1-16 of U.S. Patent No. 5,916,911 and claims 7-11 of U.S. Patent No. 6,569,889 (treating cancer), (2) claims 1-8 of U.S. Patent No. 6,051,598 and claims 8-11 of U.S. Patent No. 6,255,336 (sphingolipidosis), (3) claims 1-5 of U.S. Patent No. 6,040,332 (antimicrobial), (4) claims 1-6 of U.S. patent No. 5,952,370 and claims 12-15 of U.S. Patent No. 6,569,889 (drug resistance), (5) claims 16-19 of U.S. Patent No. 6,569,889 (angiogenesis) and (6) claims 1-5 of U. S. Patent No. 5,945,217 (vaccinations). Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims are drawn to methods differing merely in the scope of the compounds. The uses of the present compounds are obvious. Present claims 10-13 appear to be the elected subject matter of the '336 patent.

5. Claims 1-13, 15 and 16, drawn to compounds and uses, are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of copending Application No. 10/134,315. The present compounds and uses are within the genus of the compounds and uses of the copending application. The present subject matter is obvious thereover.

6. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

7. Claims 1-3, 5 and 7-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (1) Compound claims 1 and 2 are indefinite since the open-ended term “comprising” opens the claims to the inclusion other components, when in fact single compounds are intended. (2) The terms “functional homologs” and “isomers” in claims 1-3 and 8-17 are also ^{intended}inf that it is unclear exactly what structures are meant. (3) Composition claims 3-7 are incomplete in the failure to recite the presence of a carrier. Note the claim language in U.S. Patent No. 6,255,336.

Conclusion / Allowable Subject Matter

8. The present application appears to be a division of Serial No. 09/350,768 (U.S. Patent No. 6,255,336, below), claims 1-7 and 10-13 having been patented and claims 8, 9 and 14-17 nonelected therein. Present claims 1-7 and 10-13 are apparently to be canceled. Clarification is requested.

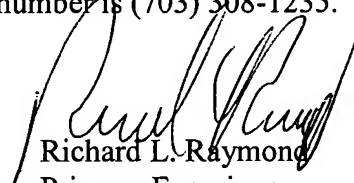
9. Upon overcoming the obviousness-type double patenting and Section 112, second paragraph, rejections with respect to claims 8, 9 and 10-17, allowable subject matter will be involved.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Raymond whose telephone number is (703) 308-4523. The examiner can normally be reached on Monday-Thursday (9:30AM-8:00PM)).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 305-4716. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



Richard L. Raymond
Primary Examiner
Art Unit 1624

IT
October 23, 2003